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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/939,922 | 08/27/2001 | Stanley P. Dabrowski | G&C 31003.1USUS | 5353 |
| 22462 | 7590 | 11/10/2003 | EXAMINER | |
| GATES & COOPER LLP HOWARD HUGHES CENTER 6701 CENTER DRIVE WEST, SUITE 1050 LOS ANGELES, CA 90045 | | | LE, UYEN CHAU N | |
| | | ART UNIT | PAPER NUMBER | 2876 |

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|-----------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/939,922 | DABROWSKI, STANLEY P. | |
| | Examiner | Art Unit | |
| | Uyen-Chau N. Le | 2876 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 29 September 2003.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 7-17 is/are rejected.
- 7) Claim(s) 6 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Prelim. Amdt/Amendment

1. Receipt is acknowledged of the Amendment filed 29 September 2003.

Drawings

2. The corrected or substitute drawings were received on 29 September 2003. These drawings are accepted by the Examiner.

Obviousness-Type Double Patenting

3. Claim 1 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,598,788 (hereinafter ‘788).

Although the conflicting claims are not identical, they are not patentably distinct from each other because in claim 1 of the instant application, Applicants claim a method of providing at least one **scrip** from a gaming device, comprising the steps of “**accepting a cash-out command in the gaming device**”, “**scanning a magnetically manifested code uniquely identifying a scrip stored in the gaming device**”, “**transmitting a cash-out message comprising the code to a remote processor having access to a database for storing and retrieving codes from a plurality of gaming devices**”, “**receiving a scrip dispense message from the remote processor**”, and “**dispensing the scrip**”. The ‘788 patent discloses a method of providing at least one **scrip** from a gaming device, comprising the steps of “**accepting a cash-out command at the gaming device**”, “**scanning a code on the pre-coded scrip in response to the cash-out command, wherein the code uniquely identifies the scrip**”, “**transmitting the code to a remote processor having access to a database for storing and retrieving codes from a**

plurality of gaming devices”, “receiving a scrip dispense message from the remote processor”, and “dispensing the scrip”. Although the scope of claim 1 of the present application and claim 1 of ‘788 patent are almost identical, the difference between the present claimed invention and the ‘788 patent is that the present claimed invention is a broader recitation of the ‘788 patent (e.g., the present claimed invention recites “scanning a magnetically manifested code uniquely identifying a scrip stored in the gaming device, etc.” whereby the ‘788 patent recites “scanning a code on the pre-coded scrip in response to the cash-out command, wherein the code uniquely identifies the scrip, etc.”). Thus, with respect to above discussions, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to use the teaching of claim 1 of ‘788 patent as a general teaching for having a method of providing at least one scrip from a gaming device with the same steps/functions as claimed by the present application. The instant claims obviously encompass the patented claims and differ only in terminology. To the extent that the instant claim is broaden and therefore generic to the patented claims [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been patented.

The obviousness-type double patenting rejection is a judicially established doctrine base upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R § 1.78(d).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-3 and 7-17 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burns (WO 94/16781 – cited by the applicant) in view of Black et al (US 4,835,624).

Re claims 1-3 and 7-17, Burns shows and discloses a method and device of providing at least one scrip from a gaming device comprising the steps of accepting a cash-out command at a gaming device from a remote processor/from a user playing the gaming device; scanning via scanning means 206 a code uniquely identifying a scrip 222; transmitting a cash-out message comprising the code to a remote processor 100 having access to a database for storing and retrieving codes from a plurality of gaming devices; receiving a scrip dispense message from the remote processor 100; and means for dispensing the scrip 222, wherein the cash-out message further comprises a cash-out balance (Fig. 1; abstract; p.4, lines 6-15; and p. 8, line 25 – p. 11, line 17).

Burns further discloses a magnetic code reader for reading a magnetic stripe 662 on the player card 660, but fails to teach or fairly suggest the scrip having a magnetically manifested code. Burns also fails to teach or fairly suggest the use of a scrip transducer for reading and recording a magnetic manifested code on a scrip.

Black et al teaches each lottery ticket 64 having a magnetic code 84, which can be read and recorded by a magnetic read head 54 and a magnetic write head 32, which serves as a transducer (figs. 4 and 5; col. 5, lines 5-39).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of into the teachings of Burns in order to provide Burns with a more secure system wherein the magnetic code can only be recognized/read by a machine/magnetic reader (i.e., a transducer or magnetic read/write head, etc.). Furthermore, such modification would have been merely a substitution of equivalents well within the ordinary skill in the art, and therefore an obvious expedient.

6. Claims 4 and 5 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Burns as modified by Black et al as applied to claim 1 above, and further in view of Walker (WO 95/24689). The teachings of Burns as modified by Black et al have been discussed above.

Re claims 4 and 5: Burns/Black et al have been discussed above but fail to teach or fairly suggest that the transmitted data is encrypted.

Walker teaches the data transmitting between the player and the wagering establishment is encrypted (figs. 1A through 2; abstract; and page 18, lines 2+).

It would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to incorporate the teachings of Walker into the teachings of Burns/Black et al in order to provide Burns/Black et al with a more secure system preventing the transmitted data from being read and/or manipulated by an unauthorized operator. Furthermore, such modification would have been an obvious extension as taught by Burns/Black et al, and therefore, an obvious expedient.

Allowable Subject Matter

7. Claim 6 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter:

The prior art of records to Burns, Black et al, Walker and all other cited references, taken alone or in combination, fails to teach or fairly suggest the specific structure or the method of a system for dispensing pre-coded scrip comprising, among other things, the magnetically manifested code is pre-coded as set forth in the claims.

Response to Arguments

9. Applicant's arguments filed 29 September 2003 have been fully considered but they are not persuasive.

10. In response to the Applicant's argument with regard to "... Burns does not teach the steps of scanning a magnetically manifested code uniquely identifying a scrip in response to a cash-out command...." and "... Burns does not teach transmitting the code/a cash-out message to a remote processor..." (page 11, paragraphs 1-3), the examiner respectfully requests the applicant to review Burns, wherein a cash-out slip with a unique control number is inserted into the machine, the barcode reader scans the barcode printed on the slip and transmits the read information to a remote CPU, the remote CPU will then verify the validity of the cash-out slip. If the unique control number is one of a plurality of valid codes, then the CPU will transmit a scrip dispense message back to the machine, and the machine will issue a scrip and dispense it to the player, which is a coupon in this case (see page 3, line 34 through page 4, line 24; page 6, lines 27-30; page 6, line 35 through page 7, line 5; page 10, line 31 through page 11, line 10). Therefore, the method and apparatus for dispensing a scrip as taught by Burns meets the claimed invention.

11. In response to applicant's argument that there is no suggestion to combine the references (page 11, last paragraph), the examiner recognizes that obviousness can only be established by combining or

modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the primary reference to Burns teaches a gaming device for dispensing a scrip comprising, among other things, a scanner for scanning a barcode scrip in response to the cash-out command prior dispensing the scrip to the player. However, Burns silent with respect to a magnetically manifested code. The secondary reference to Black et al teaches each lottery ticket 64 having a magnetic code 84, which can be read and recorded by a magnetic read head 54 and a magnetic write head 32. Accordingly, the claimed limitation, given the broadest reasonable interpretation, Burns in view of Black et al meets the claimed invention (see the rejection above).

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen-Chau N. Le whose telephone number is 703-306-5588. The examiner can normally be reached on SUN, M, W, F 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MICHAEL G LEE can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0956.


Uyen-Chau N. Le
October 24, 2003


KARL D. FRECH
PRIMARY EXAMINER